REMARKS

By this Amendment, new claims 9-11 are added to more fully recite the disclosed invention. These claims are patentable over the cited prior for at least the reasons asserted herein with regard to their base claims. Support for these new claims is provided in the specification generally and, more specifically, in Figure 1, and at page 4, line 15 to page 5, line 13. Claims 1-11 are pending.

That Office Action rejected claims 1-4 and 6-8 under 35 U.S.C. 103 (a) as being unpatentable over Joensuu et al. (U.S. Pat. 5,966,653; hereafter Joensuu), Alperovich et al. (U.S. Pat. 6,459,680; hereafter Alperovich) and Tiedemann et al. (U.S. Pat. 6,335,922; hereafter Tiedemann). Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Joensuu, Alperovich and Tiedemann in view of Dezonno (U.S. 6,449,356).

CITED PRIOR ART FAILS TO TEACH OR SUGGEST ALL CLAIM FEATURES

Applicants traverse the rejection because the combined teachings of the cited references fail to teach or suggest a method for performing a USSD transfer for transmitting data between two parties, the method being comprising "determining the amount of data to be transmitted in the USSD transfer; and if the amount of data to be transmitted in the USSD transfer is likely to exceed a predetermined threshold, and if the mobile station is not involved in a call, **directing the mobile station to call mode for performing the USSD transfer on the fast channel**," as recited in independent claim 1 and its dependent claims 2-6 and 9-11. Similarly, the combined teachings of the cited references fail to teach or suggest an arrangement for a cellular communications network, the arrangement comprising "a first logic for determining the amount of data to be transmitted; and a second logic for initiating a call attempt **for switching the USSD transfer to the fast channel** if the amount of data to be transmitted in the USSD transfer is likely to exceed a predetermined threshold and if the mobile station is not involved in a call," as recited in independent claim 7 and its dependent claim 8.

The Office Action recognized that Joensuu fails to teach or suggest both determining an amount of data to be transmitted in an USSD transfer; and if the amount of data to be transmitted is likely to exceed a predetermined threshold, and if a mobile station is not involved in a call, directing the mobile station to call mode for performing the USSD transfer on a fast channel. However, the Office Action has asserted that the combined teachings of Alperovich and Tiedemann remedies those deficiencies of Joensuu.

Nevertheless, Alperovich merely teaches determining an overall usage of SDCCH channels, and, if over-utilization of SDCCH channels is detected, instructing mobile stations to delay requesting low-level mobile service from the network. The Office Action specifically referred to passages of Alperovich as allegedly teaching determining a "level of utilization of SDCCH channels" (line 42). However, Alperovich, read as a whole, clearly teaches that this determination involves determining the overall level of utilization of SDCCH channels in the entire coverage area of a base station controller not the determination of an amount of data to be transmitted in a USSD transfer. Thus, any hypothetical combination of Joensuu and Alperovich would fail to provide the claimed invention because, even assuming for argument's sake that Alperovich's detection of over-utilization of SDCCH were equated with the claimed determination of an amount of data to be transmitted in a USSD transfer(which it cannot be), the hypothetical combination of Joensuu and Alperovich would, in response to such detecting, merely instruct mobile stations to delay requesting low-level mobile service from the network.

Even if Tiedemann were combined with Joensuu and Alperovich, the resulting combined teachings would still fail to provide the claimed invention because Tiedemann does not direct to call mode for switching the USSD transfer to a fast channel Tiedemann merely teaches dropping one or more secondary code channels to satisfy a recognized need for increased transmission capacity. However, there is no teaching or suggestion of directing a mobile station to a call mode for switching a USSD transfer to a fast channel.

Similarly, Dezonno fails to remedy the deficiencies of the other cited prior art because its teachings are limited to processing multi-media telecommunication transactions by a call processing center.

Therefore, the cited prior art fails to teach or suggest the claimed invention including a determination of the amount of data to be transmitted (in a single USSD transfer); and, if the amount is likely to exceed a predetermined threshold, and the mobile station is not involved in a call, then the mobile station is directed to call mode for switching the USSD transfer to the fast channel. Therefore, claims 1-11 are patentable over the cited prior art.

Additionally, claims 4 and 8 are patentable for the additional reason that the prior art fails to disclose, teach or suggest a network that, when initiating the USSD transfer, sends the mobile station an indication that the mobile station must initiate the call attempt, as recited in dependent method claim 4 and dependent apparatus claim 8.

The record indicates that the Office referred to particular passages of Alperovich as teaching the subject matter recited in claims 4 and 8; however, those passages have nothing to do with the subject matter recited in claims 4 and 8. Rather, those passages merely disclose conventional call set-up signalling from a network to a mobile station. Therefore, Applicants submit that any prior art rejection of claims 4 and 8 must identify what sections of Alperovich actually teach or suggest the subject matter recited in claims 4 and 8.

Similarly, Applicants further traverse the prior art rejection of claim 11 because, the prior art cited against claim 11, Dezonno, merely discloses simulating completion of an outbound call to a non-existent number. To the contrary, the subject matter of the claimed invention, and claim 11 in particular, relates to initiating a USSD transfer.

IDENTIFIED MOTIVATION TO COMBINE REFERENCES IS DEFICIENT

Further, Applicants submit that the prior art rejections of claims 1-8 are based on impermissible hindsight. The Office Action asserted that the cited prior art is "combinable" because "they are from the same field of endeavor, that is, improving the performance of USSD transfer in cellular systems" and asserted that one of ordinary skill in the art would have modified the teachings of Joensuu to include the teachings of "Alperovich/Tiedemann in order to determine if the amount of data being transmitted exceed a threshold and if so, the mobile station is directed to call mode using the FACCH."

However, in order to support a rejection for obviousness, the prior art must suggest the desirability of the claimed invention. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Thus, whether or not the cited prior art are "combinable" is irrelevant; the relevant inquiry is whether the cited prior art would have motivated one of ordinary skill to modify and combine their teachings. Thus, although it may be well known to employ a fast channel if there is more data to transmit, the prior art fails to disclose, teach or suggest employing a fast channel for large

amounts of data in the context of the present invention, namely a USSD transfer. This is because, at the time of the invention, the mechanism for sending the USSD transfer appeared well-standardized, and a person of ordinary skill in the art would not have realized that the speed of standardized USSD transfer could or should be improved.

Additionally, even assuming for argument's sake that this individual of ordinary skill would have had a vague idea that the speed of standardized USSD transfer could be improved, the prior art would have provided no guidance as to how such an improvement could be made.

As stated in Applicants' specification at page 3 lines 10 - 22, the claimed invention is partially based on Applicants' novel interpretation of call mode as specified in GSM recommendation 02.30, to which a reference is made in the application. The invention is also partially based on the discovery that USSD transfer speed can be improved if the mobile station is directed to call mode for switching the USSD transfer to the fast channel.

It is relatively simple to build a rejection based on claim elements picked and chosen from the prior art; however, the relevant inquiry, and where the rejection is deficient, is whether the prior art teaches or suggests the claimed invention as a whole. That is to say, Applicants' claimed invention is patentable over the cited prior art because the prior art does not provide motivation to direct the mobile station to call mode to initiate a USSD transfer. A call is one mode of communication, a USSD transfer is another. The prior art fails to disclose, teach or suggest why the mobile station be directed to call mode for a USSD transfer. Hence, the prior art fails to teach or suggest the claimed invention.

In fact, none of the references, analyzed individually or in combination, teaches directing the mobile station to call mode for performing the USSD transfer on the fast channel if the amount of data to be transmitted in the USSD transfer is likely to exceed a predetermined threshold, and if the mobile station is not involved in a call.

FURTHER TRAVERSAL OF PRIOR ART REJECTION OF CLAIM 5

Applicant further traverses the prior art rejection of claim 5 because one of ordinary skill in the art would not have been motivated to look to the teachings of four separate references to allegedly teach a mobile station that, when initiating the call attempt, calls a non-existent number or itself.

Accordingly, the combined teachings of the prior art fail to teach or suggest determination of an amount of data to be transmitted in an USSD transfer; and if the

amount of data to be transmitted is likely to exceed a predetermined threshold, and if a mobile station is not involved in a call, direction of the mobile station to call mode for performing the USSD transfer on a fast channel, as recited in the rejected claims. Therefore, the rejection is traversed and claims 1-11 are allowable.

All objections and rejections having been addressed, Applicant requests issuance of a notice of allowance indicating the allowability of all pending claims. If anything further is necessary to place the application in condition for allowance, Applicant requests that the Examiner contact Applicant's undersigned representative at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
PILLSBURY WINTHROP LLP

CHRISTINE H. MCCARTHY
Reg. No. 41844
Tel. No. (703) 905-2143
Fax No. (703) 905-2500

Date: February 9, 2004
P.O. Box 10500
McLean, VA 22102
(703) 905-2000